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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,875	09/25/2000	Jerry Freestone	NTL-3.2.133/3405	3055
35437	7590	10/17/2006	(12052SC)	
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO 666 THIRD AVENUE NEW YORK, NY 10017			EXAMINER WON, MICHAEL YOUNG	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>09/668,875</p>	<p>Applicant(s)</p> <p>FREESTONE ET AL.</p>	
	<p>Examiner</p> <p>Michael Y. Won</p>	<p>Art Unit</p> <p>2155</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|---|---|

DETAILED ACTION

1. This action is in response to the amendment filed July 31, 2006.
2. Claims 1, 7-9, 11, 13, 18-20, 22, and 30 have been amended.
3. Claims 1-45 have been examined and are pending with this action.

Claim Rejections - 35 USC § 101

4. The previous rejection under 35 U.S.C. 101 has been withdrawn based on the amendments to claims 1 and 8.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 12-19, 21-31, 33-41, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al. (US 5,732,216 A).

INDEPENDENT:

As per **claim 1**, Logan teaches an electronic message configured to be communicated between a sender's device and a recipient's device, the electronic message comprising:

a sound file attached to the electronic message (see col.42, line 67 to col.43, line 2: "audio file attachment to an E-mail message"); and,

a predetermined identifier, associated with the sound file, that both distinguishes said sound file from other files attached to the message (see col.7, lines 30-35: "the filenames used to specify the files in the server 125 may conveniently be formed from the program_id... to identify and differentiate the different program segments used"; and col.15, lines 12-19: "Program_ID"; and col.45, lines 52-54) and indicates a course of action to be taken by the recipient's device with said sound file (see col.7, lines 36-41: "identifies the order in which downloaded program segments are to be played").

As per **claim 8**, Logan teaches a method for sending an electronic message from a sender's device and a recipient's device comprising:

attaching a sound file to an electronic message (see col.42, line 67 to col.43, line 2: "audio file attachment to an E-mail message"); and,

associating a predetermined identifier with said sound file, which both distinguishes said sound file from other files attached to the e-mail (see col.7, lines 30-35: "the filenames used to specify the files in the server 125 may conveniently be formed from the program_id... to identify and differentiate the different program segments used"; and col.15, lines 12-19: "Program_ID"; and col.45, lines 52-54) and which indicates a course of action to be taken by the recipient's device with said sound

file (see col.7, lines 36-41: "identifies the order in which downloaded program segments are to be played").

As per **claim 24**, Logan teaches a method for announcing electronic messages comprising:

receiving an electronic message with an attached sound file (see col.42, line 67 to col.43, line 2: "audio file attachment to an E-mail message");

noting the presence of a predetermined identifier that distinguishes said sound file from other files attached to the message (see col.7, lines 30-35: "the filenames used to specify the files in the server 125 may conveniently be formed from the program_id... to identify and differentiate the different program segments used"; and col.15, lines 12-19: "Program_ID"; and col.45, lines 52-54); and,

playing the attached sound file (see col.7, lines 62-66: "played... in the sequence established") in response to the noting of the predetermined identifier (see col.7, lines 36-41: "identifies the order in which downloaded program segments are to be played").

DEPENDENT:

As per **claims 2-4, 14-16, and 26-28**, Logan further teaches wherein said sound file contains at least one word in a computer-simulated voice and at least one word in a sender's voice (see col.28, lines 19-26).

As per **claim 5**, Logan further teaches wherein the predetermined identifier is a specific file name associated with said sound file (see col.5, lines 6-15).

As per **claims 6, 17, and 29**, Logan further teaches wherein the predetermined identifier is an information tag (see col.44, lines 12-15).

As per **claims 7, 18, and 30**, Logan further teaches wherein the information tag is embedded in a header of the electronic message (see col.43, lines 5-15).

As per **claim 9**, Logan further teaches wherein said attaching is performed by the sender's device (see col.15, lines 15-19).

As per **claim 10**, Logan further teaches wherein said attaching is automatic (see col.10, lines 28-36).

As per **claim 12**, Logan further teaches wherein said attaching, is performed by an e-mail server (see col.4, lines 40-46 and col.6, lines 39-41).

As per **claim 13**, Logan further teaches wherein said attaching is, performed by the recipient's device (see col.2, lines 10-14 and col.15, lines 15-19).

As per **claims 19 and 31**, Logan further teaches wherein the information tag, is embedded by the sender's device or by a sender computer (see col.43, lines 26-33 & 46-60 and col.44, lines 12-15).

As per **claims 21 and 33**, Logan further teaches wherein the information tag, is embedded by an e-mail server (see claim 7 and 19 rejection above).

As per **claim 22 and 34**, Logan further teaches wherein the information tag, is embedded by the recipient's device or by a recipient computer (see claim 13 and 19 rejection above).

As per **claim 23**, Logan further teaches wherein said attaching, is selectively performed by a sending party (see col.11, lines 27-34).

As per **claim 25**, Logan teaches of further comprising receiving at least one more electronic message with an attached sound file and playing said at least one more sound file (see col.7, lines 51-61).

As per **claim 35**, Logan further teaches wherein said playing is selective (see col.46, lines 26-28).

As per **claim 36**, Logan further teaches wherein said playing is performed at a recipient computer (see col.1, lines 42-49).

As per **claim 37**, Logan further teaches wherein said playing is performed at recipient customer premise equipment (see col.1, lines 42-49)

As per **claim 38**, Logan further teaches where said playing is performed at a recipient voice mail (see col.15, lines 31-46).

As per **claim 39**, Logan teaches of further comprising converting the content of the electronic message to a voice message (see col.28, lines 19-26).

As per **claim 40**, Logan further teaches where said converting is performed at an e-mail server (see col.5, lines 26-31).

As per **claim 41**, Logan further teaches where said converting is performed at a recipient computer (see col.5, lines 16-26).

As per **claim 44**, Logan further teaches wherein said converting is performed using a sound file as a voice sample.

As per **claim 45**, Logan teaches of further comprising transferring said voice message to a voice mailbox (see col.15, lines 31-46 and col.29, lines 36-41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 20, 32, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. (US 5,732,216 A) in view of Agraharam et al. (US 6,085,231 A).

As per ***claims 11, 20, 32, and 42***, Logan further teaches wherein said attaching is performed by the sender's device (see claim 9 rejection above), wherein the information tag is embedded by the sender's device or by a computer at a sending party's end (see claim 7 rejection above), and wherein said converting is performed at a computer at the receiving party's end.

Logan does not explicitly teach of an adjunct to a sender or a receiver for performing these steps. Agraharam teaches of an adjunct (see col.3, lines 20-29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Logan in view of Agraharam so that the attaching, embedding, or converting is performed by an adjunct. One would be motivated to do so because Logan teaches that numerous embodiments may be made to the structure and functions without departing from the spirit and scope of the

invention (see col.45, lines 19-25). Therefore, by separating functionality into different adjunct devices, load on one processor is reduced.

As per **claim 43**, Logan does not explicitly teach wherein said converting is performed at a voice messaging system.

Agraharam teaches wherein said converting is performed at a voice messaging system (see Fig.2, #202 & #206 and col.4, lines 7-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Logan in view of Agraharam so that the converting is performed at a voice messaging system. One would be motivated to do so because Logan teaches that compressed audio or text can be "converted into audio form by a conventional speech synthesis program" (see col.3, lines 37-41).

Response to Arguments

7. In response to the remarks regarding the Examiner's Interview conducted on July 27, 2006, the examiner would like to clarify of record that no such agreement was made that if the applicant(s) overcame the 101 rejection that the present invention would be novel over the presently cited art (US 5,732,216 Logan et al.).

The examiner stated during the interview, that the **description given by the applicant(s) representative** was something different than the prior art, Logan. However, the examiner stressed that the pending claims **did not reflect** the description of the invention as given by the applicant(s) representative. The examiner also stressed

that such descriptions must be explicitly stated in the language of the claims to overcome Logan, wherein an amendment overcoming the 35 U.S.C 101 rejection could be one possibility (if the amendment explicitly stated the invention).

In the interview summary, the examiner clearly marked the “g) was not reached” because no explicit agreement was reached. Therefore, claims 1-45 remains rejected and pending as set forth in the rejection above.

A. The applicant(s) argue that Logan does not teach of an identifier that (1) distinguishes that sound file from other sound file from other sound files attached to that email and (2) indicates a course of action to be taken by the recipient’s computer with the sound file.

In response to the applicant(s) argument, specific reference locations have been pointed to, to better and explicitly teach these features (see rejection set forth above).

Claims 2-7, 9-10, 12-19, 21-23, 25-31, 33-41, and 44-45 which depends on independent claims 1, 8, and 24 have also been rejected based on the rejection set forth above.

B. The applicant(s) argue that Agraharam does not cure the deficiencies of Logan and therefore the claims are novel over Logan and Agraharam and further that the references are improper to combine.

In response to the applicant(s) argument above, Agraharam is not relied upon to teach the limitations of claims 1, 8, and 24 because Logan explicitly teaches these limitations.

In response to applicant's argument that the references are improper to combine, the applicant(s) give no explanation why it is improper, but merely asserts that it is. Clearly both references pertain to similar objectives which is sending audio files from a sender to a recipient and therefore, clearly combinable.

Conclusion

8. For the reasons above, claims 1-45 have been rejected and remain pending.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

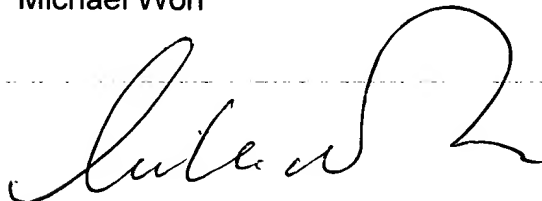
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won



October 10, 2006



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER